

Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed July 8, 2008. Currently, claims 12-42 remain pending of which claims 12-26 were previously withdrawn. Claims 27-42 have been rejected. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 112

Claims 27-42 were rejected under 35 U.S.C. 112, first paragraph, as being indefinite for failing to comply with the written description requirement. Applicant has amended claims 27, and 31-37 to further prosecution of this case. As such, this rejection is considered moot.

Claims 27-42 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 27, and 31-37 to further prosecution of this case. As amended, claim 27 now indicates that the invention includes a captivation tool, an elongated shaft, and an embolic protection device, but not a catheter. New claim 43 has been added to further clarify by claim differentiation that the catheter is not a claimed element of the captivation tool / elongated shaft / embolic protection device combination *per se*. The force necessary to translate the elongated shaft within the slot of the claimed system is greater than the force necessary to translate the elongated shaft within the slot in the absence of magnetic coupling. As will be appreciated by a careful reading of the claim, the reference to a catheter in claim 27 confirms that the magnetic section will remain coupled to at least one magnetic region thereby providing increased resistance to translation when the elongated shaft is contained within a catheter, said containment having the effect of spacing the elongated shaft away from the bottom of the longitudinal slot. The clause indicates that the catheter need not be present; however when it is, the translational force in the presence of magnetic coupling is still increased over the force required in the absence of the magnetic coupling. Other matters relating to antecedent basis have been corrected as well. Accordingly, this rejection is considered moot.

Claim Rejections – 35 USC § 102

Claims 27-39 were rejected under 35 U.S.C. 102(b) as anticipated by Thome et al. (U.S. Patent No. 5,776,080), hereinafter Thome. After careful review, Applicant must respectfully traverse this rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See MPEP § 2131). Nowhere does Thome appear to teach or suggest, “wherein the elongated shaft further comprises an embolic protection device” or “translational displacement of said embolic protection device being fixed at one of several displacements relative to the captivation tool”, as recited in claim 27.

Instead, Thome appears to teach fixing a guidewire, without an embolic protection device, in a single position so that a catheter may be slidably removed from the guidewire. Accordingly, Thome does not appear to anticipate *each and every element as set forth in the claim* and Applicant respectfully requests that the rejection be withdrawn.

Additionally, for similar reasons as well as others, claims 28-39, which depend from claim 27, and include significant additional limitations, are believed to be not anticipated by Thome and Applicants respectfully request that the rejections be withdrawn.

Claim Rejections – 35 USC § 103

Claims 40-42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Thome in view of Boyle (U.S. Patent No. 6,939,362). After careful review, Applicant must respectfully traverse this rejection.

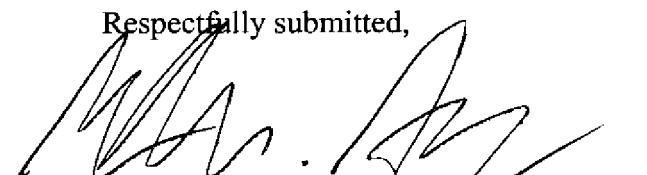
“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP § 2143.03). As discussed previously, nowhere does Thome appear to disclose “wherein the elongated shaft further comprises an embolic protection device” or “translational displacement of said embolic protection device being fixed at one of

several displacements relative to the captivation tool", as recited in amended claim 27 from which claims 41-42 depend. (Claim 40 has been canceled.) Other than explicitly acknowledging that Thome does not disclose that there is an embolic protection filter disposed on the elongate shaft, the Examiner is silent with respect to a possible combination of Thome and Boyle. Instead of discussing that combination, the Examiner makes reference to an unidentified Pflueger reference suggesting that it would have been obvious to one of ordinary skill in the art to incorporate the filter of Boyle into an angioplasty catheter of Pflueger. Assuming that the Pflueger reference in question is U.S. 6,013,038, the combination of Pflueger and Boyle has been previously discussed and found to be deficient in that the Pflueger reference appear to disclose an apparatus in which a catheter is held between the pole pieces of one or more C-shaped magnets rather than "being in contact with at least the bottom surface of the longitudinal slot of the captivation tool" and adjacent to "a linear array comprising a plurality of magnetic sections disposed along and parallel to the slot". Additionally, for similar reasons, as well as others, claims 41 and 42, which depend from claim 27 and include significant additional limitations, are believed to be patentable over Thome in view of Boyle and Applicant respectfully requests withdrawal of the rejections.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

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Respectfully submitted,



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